

### **REMARKS**

In the outstanding Office Action, the Examiner rejected claims 1-7<sup>1</sup> under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,121,689 to Capote et al. ("Capote"); and rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Capote in view of U.S. Patent No. 6,077,726 to Mistry et al. ("Mistry"). By this amendment, Applicant has amended claim 1. Claims 1-20 remain pending, with claims 1-8 presented for examination.

#### **I. Rejections under 35 U.S.C. sec. 102(b)**

Regarding the rejection of claims 1-7 under 35 U.S.C. § 102(b), Applicant respectfully disagrees with the Examiner's arguments and conclusions as set forth in the outstanding Office Action<sup>2</sup>. Accordingly, Applicant respectfully traverses this rejection.

In order to properly anticipate Applicant's claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See MPEP § 2131, 8th Ed. (Rev. 2), May, 2004.

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<sup>1</sup> Although at page 2 of the Office Action the Examiner indicates that only claims 1-5 are rejected under 35 U.S.C. § 102(b), it is noted that the Examiner specifically rejects claims 6 and 7 under 35 U.S.C. § 102 (b) as well at page 3 of the Office Action.

<sup>2</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

Applicant submits that Capote cannot anticipate claim 1, for at least the reason that reference fails to teach the combination including “a low dielectric constant insulating film formed on a surface of the semiconductor chip, a passivation film formed on a surface of the low dielectric constant insulating film,” as recited in amended claim 1. Capote, in FIG. 15, for example, teaches forming two bonding layers 32 and 34 on chip 10 wherein “chip bonding layer 21 is a thin polymer or coupling agent, with high adhesion to the chip passivation layer (not shown) on the face of the chip 10.” Capote, col. 11, lines 29-32. Capote thus teaches that passivation layer is formed on the face of chip 10, and chip bonding layer 21 is formed over the passivation layer such that it adheres to the passivation layer. Moreover, Capote is silent as to a “low dielectric constant insulating film.” Accordingly, Capote fails to teach “a low dielectric constant insulating film formed on a surface of the semiconductor chip, a passivation film formed on a surface of the low dielectric constant insulating film,” as recited in amended claim 1 (emphasis added).

In addition, the Examiner states that Capote teaches “a low dielectric constant insulating film formed on a surface of the semiconductor chip (col. 10, lines 40-41).” Office Action, page 2. The cited portion of Capote, however, states: “[g]enerally, the chip 10 is passivated with a thin layer of either silicon nitride, polyimide, or benzocyclobutene.” This merely teaches providing a passivation film somehwere on chip 10, and accordingly cannot constitute a teaching of “a low dielectric constant insulating film formed on a surface of the semiconductor chip, [and] a passivation film formed on a surface of the low dielectric constant insulating film,” as recited in amended

claim 1 (emphasis added). Hence, amended claim 1, as well as claims 2-7 are not anticipated by Capote, and thus are allowable over Capote. Accordingly Applicant respectfully requests that the rejection of claims 1-7 under 35 U.S.C. § 102(b) be withdrawn.

**II. Rejection under 35 U.S.C. sec. 103(a)**

Regarding the rejection of claim 8 under 35 U.S.C. § 103(a), Applicant respectfully disagrees with the Examiner's arguments and conclusions as set forth in the outstanding Office Action. Accordingly, Applicant respectfully traverses this rejection.

To establish a prima facie case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See MPEP §2143.03, 8th Ed. (Rev. 2), May, 2004. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." See MPEP § 2143, 8th Ed. (Rev. 2), May, 2004.

Claim 8 depends from claim 1, and thus requires all of the elements recited in claim 1. As discussed above, Capote fails to teach at least "a low dielectric constant insulating film formed on a surface of the semiconductor chip, a passivation film formed

on a surface of the low dielectric constant insulating film,” as recited in claim 1, and required by claim 8. Mistry fails to cure this deficiency of Capote.

Mistry is cited because the reference allegedly “teaches a passivation film comprising at least one layer formed of an organic film coating a connecting electrode.” Office Action, page 4. Mistry teaches “forming a polyimide layer (16) over a passivation layer (14).” Mistry, abstract (emphasis added). Mistry thus fails to teach “a low dielectric constant insulating film formed on a surface of the semiconductor chip, a passivation film formed on a surface of the low dielectric constant insulating film,” as recited in amended claim 1, and required by claim 8.

Since neither Capote nor Mistry teaches or suggests every element required by claim 8, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejection of claim 8 under 35 U.S.C. § 103(a) be withdrawn.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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